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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/015,967 | 12/07/2001 | Dan L. Eaton | P1447R1 | 9428 |

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| EXAMINER | |
|---|---|
| JIANG, DONG | |
| **ART UNIT** | **PAPER NUMBER** |
| 1646 | |

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Advisory Action | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/015,967 | EATON ET AL. | |
| | Examiner | Art Unit | |
| | Dong Jiang | 1646 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 19 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *19 August 2004*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☒ The proposed amendment(s) will not be entered because:

(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: *See Continuation Sheet*.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *33-43*.

Claim(s) withdrawn from consideration: _____.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Lorraine Spector

LORRAINE SPECTOR
PRIMARY EXAMINER

Continuation of 2. NOTE: the newly amended claim 33 with the addition of the claim limitation of "which is capable of chemoattracting ..." raises new issues that would require further consideration under 35 U.S.C. 112, and new ground of rejection, as it is unclear under what condition the polypeptide is "capable of" doing so, and the claim would be indefinite. Therefore, the proposed amendment does not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. .

Continuation of 5. does NOT place the application in condition for allowance because:
Claims 33-37 remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of records set forth in the previous Office Actions, mailed on 06 June 2003 and 06 April 2004.

Further, claims 33-42 remain rejected under 35 U.S.C. 102(b) as being anticipated by Lal et al., WO 200000610-A2 (06 Jan.-2000), for the reasons set forth in the previous Office Actions.
Applicants argument filed on 19 August 2004, has been fully considered, but is not deemed persuasive for reasons below. At page 10 of the response, Applicants argue that the rejection is improper as the Examiner's position appears to be that by merely naming a polypeptide sequence, and without providing any information regarding biological role, function or activity of the polypeptide that would enable one of skill to use the polypeptide in any manner, the Lal reference anticipates the present polypeptide under 35 U.S.C. 102(b), and that applicants observations on the scientific deficiencies of the Lal reference have not been contested by the Examiner.
Applicants argument has been fully considered, but is not deemed persuasive because the Examiner has address the issue clearly in the last Office Action, and would like to repeat that the statute of 102(b) itself merely requires that "the invention was patented or described in ...", i.e., in order to be qualified as 102(b) art, a reference only needs to teach how to "make" the product, but not necessarily how to "use". The present invention is directed to a product, an isolated polypeptide, which sequence was disclosed in the prior art reference. Therefor, the invention was described in the prior art reference, and it has taught one skilled in the art how to make the polypeptide by following the sequence disclosed. As such, whether the Lal reference provides any information regarding biological role, function or activity of the polypeptide is irrelevant with respect to the rejection, and it does not affect the reference being anticipating art for the rejection of the present claims under 35 U.S.C. 102(b).

Furthermore, claim 43 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Lal et al., WO 200000610-A2 (06 Jan.-2000) as applied to claims 33-42 above, and further in view of Capon et al. (US 5,116,964), for the reasons set forth in the last Office Actions, mailed on 06 June 2003 and 06 April 2004..